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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,011	03/15/2001	Ulhas S. Warriar	42390P10851	8561

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EXAMINER
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DENNISON, JERRY B

ART UNIT	PAPER NUMBER
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2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/811,011

Applicant(s)

WARRIER ET AL.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,6-24 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-24 and 28-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Action is in response to the Amendment for Application Number 09/811,011 received on 3 October 2006.
2. Claims 1, 2, 4, 6-24, 28-35 are presented for examination.

### ***Claim Interpretation***

3. Claim 17 includes the limitation, "to allow network traffic sent to the external address to be received by the network driver."
4. Claim 21 includes the limitation, "to allow said application program to embed the WAN address within the network traffic data."

Any language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106, section II, subsection C for specific examples.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 includes the limitation "sending the packet from the first machine to the second

machine via the network configuration server...” Examiner is unable to locate this functionality in the instant specification. It is understood by Examiner that the first machine is in a private network behind a NAT access point (Figure 4 of the instant application), and the second machine is external to the private network. This would require the communication to be via the NAT access point and not the server that is “external to the private network.”

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites the limitation, “without breaking a protocol utilized for communication between the first and second machines.” Claim 1 then recites the limitation, “sending the packet from the first machine to the second machine via the network configuration server based on at least in part on the network configuration data and the destination address”.

It is unclear how the redirection takes place from the server to the second machine. Since the network configuration data and the destination address are embedded in the data portion of a packet, the packet would have to be decapsulated in order for the server to determine where to send the packet. If the packet layers are

Art Unit: 2143

never “broken” (i.e. without breaking a protocol), the destination address is never shown to the server. Therefore, it is unclear to Examiner how such functionality is performed “without breaking a protocol” since decapsulation would have to take place for the server to determine the address. It is unclear to Examiner how the redirection takes place in the server.

7. Claim 1 includes the limitation “sending the packet from the first machine to the second machine via the network configuration server...” It is unclear to Examiner how the first machine sends the packet through the network configuration server and not a NAT access point since the first machine has a private network address that is “subject to NAT.”

8. Claim 1 includes “receiving network configuration data that is not subject to NAT.” The scope of this limitation is unclear. Does it mean that the packet(s) containing the network configuration data that are received do not need to be translated as they pass through a NAT access point to the first machine? Does it mean the configuration data itself, when used by the first machine, does not need to be translated when passed through a NAT access point? Examiner is also unclear as to why it matters that the network configuration data is not subject to NAT if the data is simply used only in the data portion of a packet. Therefore, the network configuration data is simply being used as data. Examiner strongly suggests, in addition to clarifying the above issues, to use language other than “subject to NAT” as it is unclear what this

language means. Using such language also makes unclear whether such subjection to NAT is required, therefore raising the issue of whether such limitation has weight.

9. Claim 1 includes receiving network configuration data from an external server, embedding the network configuration data in a data portion of a packet, and sending the packet to a second machine via the server based at least in part on the network configuration data and the destination address.

It is unclear what the point is of the server sending the configuration data to the first machine in the first place if all the first machine does is send it directly back to the server. The phrase "based at least in part on the network configuration data and the destination address" does not explain how the configuration data is used or why it would be based on the configuration data to send the configuration data in the data portion no less. The phrase is unclear as to how the sending is based on the destination address since the destination address is in the data portion of the packet. The claim does not say it is in the header of the packet, and it is therefore unclear as to how to base the sending on the destination address. There does not appear to be any association between the network configuration data and the second machine. In regards to the claimed invention, Examiner does not see a reason to have the configuration data since it has no functional interrelationship with anything else in the claim.

10. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See

MPEP § 2172.01. The omitted steps are: The claim does not explain the format of the packet other than what is included in the data payload. There is no step of how the packet is addressed. There is no step including actual network address translation. There is no explanation as to how the packet is sent to the second machine via the server without breaking a protocol. There is also no step as to how the configuration data is used, other than sending it in a packet.

11. Claim 2 recites the limitation, “for receiving network traffic sent to the network address.” It is unclear to examiner what is receiving the network traffic.

12. Claim 6 includes method steps, however, it is unclear where these method steps are performed. There is no functional interrelationship between the limitations of the claim. Claim 6 includes the limitation, “receiving a request for a first address of a first machine on the first network.” It is unclear to Examiner what receives the request. Claim 6 includes the limitation, “allocating a second address from a server on the second network.” It is unclear to Examiner what is allocating the address. Claim 6 includes the limitation, “providing the second network address in response to the request.” It is unclear to Examiner what is providing the second network address.

13. Claim 6 includes the limitation, “using the second network address in the payload of the packet to provide a network configuration for a communications exchange.” It is unclear to Examiner how using a network address provides a network configuration.

14. Claim 6 recites the limitation, "using the second network address in the payload of the packet to provide a network configuration for a communications exchange." It is unclear as to what is using the second network address, and it is also unclear who it is being provided to.

15. Claim 17 includes method steps, however, it is unclear where these method steps are performed. Claim 17 recites the limitation, "allocating an external address on an external network." It is unclear what is performing this step.

16. Claim 17 recites the limitation, "providing the external address to the network driver of the first machine using a payload portion of a data packet." It is unclear to Examiner as to what is providing the external address. It is also unclear to Examiner how the payload portion is used.

17. Claim 21 includes method steps, however, it is unclear where these method steps are performed. Claim 21 includes the limitation, "providing layer based network services..." It is unclear to Examiner as to what is providing these layer-based services. Claim 21 includes the limitation "executing an application program". It is unclear to Examiner as to what is executing the application program. Claim 21 includes the limitation, "providing a WAN address to said application program." It is unclear to Examiner what is providing the WAN address.



18. Claim 28 includes an apparatus performing a process steps. However, certain limitations of the claim are performed by other devices. For example the fifth limitation reads "performing network address translation (NAT) on the packet by the access point of the packet origin." It is unclear to Examiner

19. The amendment filed is insufficient to overcome the ***Claim Rejections - 35 USC § 103***. The rejections are maintained and cited as stated below.

20. Claims 1, 2, 4, 6-24, 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al. (U.S. Patent Number 6,381,646) in view of Molitor (U.S. Patent Number 6,661,799).

21. Zhang and Molitor were applied for claims' rejection, cited in the previous Office Action, which are applicable, hereby incorporated by references.

### ***Response to Arguments***

Applicant's arguments and amendments filed on 10/03/2006 have been carefully considered but they are not deemed fully persuasive.

Since the claims are still replete with claim objections and 112 rejections, Examiner cannot reasonably define the scope of the invention. Therefore, Applicant's arguments are noted, however Examiner maintains the views previously provided. The rejection issued in the Final Office Action mailed 06/10/2005 remains applicable for

Art Unit: 2143

rejecting the claims as they are currently presented, and is therefore incorporated by reference.

It is noted that the Applicant has made no attempt to show why each and every amendment made to the claims have any sort of patentable novelty or advantage. Applicant makes general arguments that the prior art does not disclose certain limitations. Examiner is not persuaded by arguments that simply state that the prior art does not disclose a limitation without an explanation of why the art does not disclose the limitation.

MPEP 714.04 states:

"In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should not be allowed. See 37 CFR 1.111 and MPEP 714.02."

Therefore, the case is not in condition for allowance.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in a manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2143

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